

REMARKS

The above amendments and following remarks are submitted in response to the Official Action of the Examiner mailed July 1, 2005. Having addressed all objections and grounds of rejection, claims 1-25, being all the pending claims, are now deemed in condition for allowance. Reconsideration to that end is respectfully requested.

Claims 1-25 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting. Because no claim of the subject application has yet been allowed, it is deemed premature for Applicants to respond. However, the provisional rejection is duly noted and Applicants will provide an appropriate response when the matter becomes ripe.

The Examiner has rejected claims 1-25 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,721,727, issued to Chau et al (hereinafter referred to as "Chau"). This ground of rejection is respectfully traversed as to amended claims 1-25 for the reasons provided below.

The standard for the finding of anticipation during the examination process may be found in MPEP 2131, which states in part:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH
EVERY ELEMENT OF THE CLAIM
"A claim is anticipated only if each and every element
as set forth in the claim is found, either expressly or

inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (emphasis added)

The rejection of amended claims 1-25 as anticipated by Chau is respectfully traversed because "each and every element as set forth in the claim[s] is" not "found, either expressly or inherently described" in Chau and to the extent found in Chau, "the identical invention" is not "shown in as complete detail as is contained in theclaim"..

With regard to the rejection of claim 1, the first limitation is a piece of hardware (i.e., "user terminal") coupled to a second piece of hardware (i.e., a "legacy data base management system") via a the claimed network. In making his rejection, the Examiner surprisingly states:

a. a user terminal coupled to said legacy data base management system via said publicly accessible digital data communication network (i.e., the XML system supports legacy flat files) (col. 8, lines 15-21) and (col. 44, lines 40-45);

The statement is particularly confusing, because the material cited from Chau (i.e., col. 8, lines 15-21 and col. 44, lines 40-45) does not even directly related to the hardware elements claimed and in fact does not relate to any hardware at all. To the extent that the Examiner confuses a computer program which

"supports legacy data flat files" with the claimed piece of hardware, his finding is clearly erroneous.

With regard to the second element of claim 1, the Examiner states:

b. a service request generated by said user terminal transferred to said legacy data base management system for honoring (col. 6, lines 1-55); and

Again, the Examiner confuses the matter by citing extensive material (i.e., nearly an entire column of text) from Chau having nothing to do with the claimed element. Column 6, lines 1-55, of Chau discusses alternative, off-the-shelf, software embodiments of a single computer (i.e., server computer 104 of Fig. 1). More specifically, Chau says nothing of the claimed "service request"; nothing of the claimed "generation" of the service request by the claimed user terminal; and nothing of the claimed "honoring" of the service request by the legacy data base management system.

In addressing the third element of claim 1, the Examiner states:

c. a facility located with¹ said user terminal (Fig. 10, seep (sic) 1006) which inserts a call to native script into said service request (i.e., internet or intranet) (col. 5, lines 50-52).

Once again, these citations have nothing to do with the claimed invention. Fig. 10 describes the operation of "XML system software" (see column 3, lines 49-51) which is all located within

¹The claim requires "within" not simply "with" as suggested by the Examiner.

server computer 104 (see Fig. 1). Therefore, whatever "step 1006" of Fig. 10 does, it cannot be the claimed "facility located within said user terminal". Secondly, step 1006 of Fig. 10 describes only mapping of data between "the relational data" and "XML documents". Thus, it has nothing to do with the claimed "call" or the claimed "native script". Finally, the citation of column 5, lines 50-52, mentions data flow within a "B2B" application, having nothing to do with the claimed invention or Fig. 10.

Having therefore none of the three claimed elements of claim 1, Chau cannot possibly be found an anticipation under MPEP 2131. The rejection of claim 1, and all claims depending therefrom, is respectfully traversed.

Claim 2 depends from claim 1 and further limits the "native script" called by the "service request" generated by the "user terminal". In making his rejection, the Examiner confusingly cites the abstract of Chau. This text discusses the disclosure of Chau which involves conversion of data. It says nothing of any "script" much less the claimed "native script" or the claimed "command language". The rejection of claim 2 is respectfully traversed.

Claims 3 and 25 depend from claims 2 and 24, respectively. Claim 3 further limits the "service request" generated by the claimed "user terminal", whereas claim 25 further limits the

"response" received by the "user terminal". In making his rejection, the Examiner apparently does not distinguish between the claimed "service request" and the claimed corresponding "response". Therefore, he cites Chau, column 3, lines 15-21, which says nothing of either a "service request" or a "response" to a service request. The citation discusses data contained in XML messages. The rejection of claims 3 and 25 is respectfully traversed for failure of the Examiner to address the claimed invention as required by controlling law.

Claims 4, 8, and 13 depend from claims 3, 7, and 12, respectively. Though all three of these claims has a different scope with different limitations, they are all further limited by a "repository" for the storage of executable script. In making his rejection, the Examiner cites column 4, lines 25-31, column 16, lines 45-54 and Figs. 2, 4, and 10. The claimed "repository" is a physical hardware element. None of the extensive citations of the Examiner has anything to do with the claimed "repository" or any hardware element, for that matter. The citations all refer to software logic. The rejection of claims 4, 8, and 13 is respectfully traversed.

Claims 5, 10, 15, and 19 depend from claims 4, 9, 14, and 18, respectively, and further limit the coupling network of the claimed invention. In making his rejection, the Examiner cites Chau column 5, lines 50-52, which is limited exclusively to B2B

applications. Therefore, this citation is not pertinent to the claimed invention. The rejection of claims 5, 10, 15, and 19 is respectfully traversed.

Claim 6 is an independent apparatus claim having five separate element coupled together in a specific manner. In response to the first element, "publicly accessible digital data communication network", the Examiner cites column 5, lines 50-52 which states:

For B2B applications, application data flows between database servers, via any network (e.g., the internet or and intranet),....

This citation clearly limits the Internet use to "data flows between database serves" which has nothing to do with the claimed invention, and it is clearly limited to Business to Business systems, thereby further distinguishing itself from the claimed invention.

The second claim element is a "database management system having an internal format different from XML". The Examiner cites column 7, lines 66-67, which states:

A user can access XML column data mainly through the SQL and XML System's user definition function (UDF).

Whereas it is certainly unlikely that this citation teaches the claimed "data base management system", it is clear that whatever is being disclosed does not have the claimed "internal format different from XML". In fact, it specifically discusses access

to "XML column data". Not only does Chau not teach the claimed element, it teaches away from the claimed element.

The third element is an "XML message" transferred via the claimed network (i.e., claim element a). The Examiner cites again cited column 5, lines 50-52, which is limited to B2B applications.

In finding the fourth claim element within Chau, the Examiner cites column 3, lines 15-21, which apparently mentions a commercial software product named "XPath" but says nothing of the claimed "converter", because no conversion is required. "XPath" is used to process XML documents.

The final claim element is a "module" which embeds "native script" into the claimed service. Though the Examiner cites column 7, line 66, through column 8, line 5, Chau does not mention "embedding native script into a service" as claimed. The XML messages of Chau are used to transfer data only. There is no showing that Chau ever transfers script of any kind in an XML document. Therefore, the rejection of claim 6, and all claims depending therefrom, is respectfully traversed.

Claims 7 and 14 depend from claims 6 and 13, respectively, and further limit the claimed "native script" and the "internal format" of the claimed "database management system". As explained above, Chau discloses a system for processing XML documents (see for example the title). There is no incompatible

"internal format" as claimed and no claimed "native script". The rejection of claims 7 and 14 is respectfully traversed.

Claim 9 depends from claim 8 and is further limited by a "response" generated by the claimed "database management system". Chau has no "database management system". Therefore, Chau cannot have the claimed "response". The rejection of claim 9 is respectfully traversed.

Claim 11 is an independent method claim having four steps. The first step requires: "transferring an XML document having a call to native script to said legacy data base management system via a publicly accessible digital data communication network". Chau has no "call to native script" within an XML document. In addition, Chau has no "legacy data base management system" coupled to a "publicly accessible digital data communication network" or otherwise. The Examiner's non-pertinent citations of Fig. 1 and column 4, lines 15-24, have nothing to do with the claimed element. As explained above, the second, "converting", step is not taught by nor needed by Chau, because it does not have the claimed "legacy data base management system" with the claimed "incompatible internal format".

Chau does not have the "embedding" step, because it does not have the claimed "native script". This limitation is certainly not found within the cited column 8, lines 15-46, or column 44, lines 40-44, of Chau or elsewhere. The fourth step requires

presentation of the converted XML document to the claimed "legacy database management system" which is not found in Chau. The rejection of claim 11 is respectfully traversed.

Claim 12 depends from claim 11 and further limits the "converting" step. Because Chau does not have the claimed converting step, it cannot have this further limitation. The rejection of claim 12 is respectfully traversed.

Claim 16 is an independent apparatus claim having "means-plus-function" limitations. The "providing means" requires "providing legacy data base management". Because this limitation is not found in Chau, the Examiner cites column 75, lines 30-50, and column 4, lines 15-24, which are unrelated to the claim element. Chau also does not show the "embedding means". It has no "call to native script" and has no "legacy data base management system". The rejection of claim 16 is respectfully traversed.

Claim 17 depends from claim 16 and further limits the "providing means" wherein the "providing means" is not found in Chau. In support of his clearly erroneous findings, the Examiner cites column 4, lines 25-31, and Fig. 4, item 404, having nothing to do with the "providing means" or the further limitations of claim 17. The rejection of claim 17 is respectfully traversed.

Claim 18 depends from claim 17 and is further limited by a "defining means for defining the native service". Because this

limitation is not found in Chau, the Examiner confusingly cites column 8, lines 15-46, and column 44, lines 40-44. The rejection of claim 18 is respectfully traversed.

Claim 20 depends from claim 19 (and therefore from claim 18) is further limited by "storing means" for storing the "defining means" of claim 18 "for future use". Chau says nothing about storage for future use. The rejection of claim 20 is respectfully traversed.

Claim 21 is an independent apparatus claim having three basic elements. Chau has none of these elements. The first element is a "user terminal" which makes an XML data processing service request and receives a corresponding response. In making his rejection, the Examiner makes numerous mutually unrelated citations. Nowhere in these extensive citations is there a "user terminal", because it is concerned with Business to Business (B2B) transactions. Having not addresses a "user terminal", the citation says nothing of the "data processing service request", the "response", or the claimed "converter".

The third claim element is a "legacy database management system". Such an element is mention nowhere within Chau. The rejection of claim 21 is respectfully traversed.

Claim 22 depends from claim 21 and further limits the "legacy database management system" not found within Chau to include a "mainframe computer". In making his rejection, the

Examiner cites column 111, lines 28-34, of Chau which parenthetically mentions a "mainframe" computer. However, because Chau does not have the "legacy database management system", it cannot have the limitations of claim 22. The rejection of claim 22 is respectfully traversed.

Claim 23 depends from claim 22 and further limits the software architecture of the "user terminal" to that of an "industry standard personal computer". In making his rejection, the Examiner cites Fig. 1 of Chau which says nothing of the software architecture of any device, which could be Macintosh, IBM 360, etc. The rejection of claim 23 is respectfully traversed.

Claim 24 depends from claim 23 and further limits the claimed "legacy database management system". Because Chau does not have this element, it cannot have the further limitations of claim 24. The rejection of claim 24 is respectfully traversed.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-25, being the only pending claims.

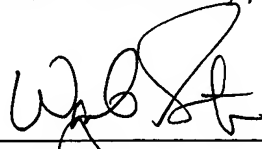
Please charge any deficiencies or credit any overpayment to
Deposit Account No. 14-0620.

Respectfully submitted,

Thomas N. Turba et al.

By their attorney,

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Wayne A. Sivertson
Reg. No. 25,645
Suite 401
Broadway Place East
3433 Broadway Street N.E.
Minneapolis, Minnesota
55413
(612) 331-1464